REMARKS

The applicants note with appreciation the acknowledgement of the claim for priority under section 119 and the notice that all of the certified copies of the priority documents have been received.

The applicants acknowledge and appreciate receiving an initialed copy of the form PTO-1449 that was filed on January 27, 2004.

Claims 1 – 2 and 4 – 8 are pending. Claim 3 has been canceled, and new claims 4 – 8 have been added. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1 – 3 were rejected under 35 USC 112, second paragraph, as being indefinite. The claims have been carefully reviewed for instances of indefiniteness, including those identified in the office action. The claims have been amended where appropriate.

Nevertheless, it is pointed out that the "holding part" in claim 1 has antecedent basis in current line 14. Moreover, it is respectfully submitted that the terminology "holding lip elastically contacts," considered as part of a whole phrase, is definite and not repetitious. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1 and 3 were rejected under 35 US 103(a) as being unpatentable over U.S. Patent 5,538,317, Brocke et al. ("Brocke") The rejection is respectfully traversed for reasons including the following, which are provided by way of example.

Claim 1 is directed to an attachment structure. Claim 1 recites, in combination, that the weather strip is attached by "said inserting part of said base portion being inserted in said

channel such that said holding lip elastically contacts an other of said side walls defining said channel." The channel part has "a U-shaped cross-section and including side walls."

On the other hand, without conceding that Brocke discloses any feature of the present invention, in the sealing arrangement of Brocke, the gap seal 3 is secured with its U-shaped clamping area 13 onto a vertical protruding edge 12 of the base frame 10. The reinforcement 14 provided in the clamping area 13 serves to secure the gap seal 3 to the vertical protruding edge 12. The lip 17 or 53 of Brocke acts as a sealing lip and compensates for the tolerances between it and the glass panel 2. It does not secure the gap seal 3 to the base frame 10. The above-described sealing arrangement of Brocke fails to teach or suggest a "channel part" as further recited in claim 1, or a "base portion including an inserting part" as further recited in claim 1.

In the attachment structure of the present invention, the weight can be reduced by not providing a metal insert in the base portion. By inserting the inserting part of the base portion in the channel of the channel part such that the holding lip elastically contacts the other of the side walls defining the channel, the inside wall of the channel part can be held by the holding part and the inserting part with a sufficient force, so that the weather strip can be readily and stably attached to the motor vehicle.

To properly reject a claimed invention, the examiner must establish a *prima* facie case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the teaching or suggestion to make the claimed combination

and a reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The examiner bears the burden of establishing this *prima facie* case. In re Deuel, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The applicants have provided herein a selection of some examples of limitations in the claims which are neither taught nor suggested by Brocke. Hence, Brocke fails to teach or suggest the combination of features recited in independent claim 1, when considered as a whole.

New claims 4 – 8 have been added to further define the invention, and are believed to be patentable for reasons including these set out above.

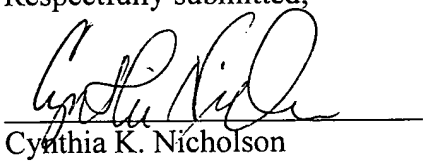
The applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples the applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



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